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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte AMANDA E. CHESSELL and KAMORUDEEN L. YUSUF

Appeal 2016-005402
Application 13/356,571¹
Technology Center 3600

Before JOHN A. EVANS, JAMES W. DEJMEK, and
STEVEN M. AMUNDSON, *Administrative Patent Judges*.

EVANS, *Administrative Patent Judge*.

DECISION ON REQUEST FOR REHEARING

¹ The Appeal Brief identifies International Business Machines Corporation as the real party in interest. App. Br. 2.

INTRODUCTION

Appellants request rehearing of the Patent Trial and Appeal Board’s (“Board”) Decision mailed October 25, 2017 (“Decision”), in which we AFFIRMED the rejection of Claims 6–15 under 35 U.S.C. § 101 as being directed to unpatentable subject matter.²

ANALYSIS

In the Request for Rehearing (filed December 26, 2017, “Request” or “Req.”), Appellants allege that the Board misapprehended or overlooked certain arguments so as to consider their claims as directed to unpatentable subject matter. Req. 2–5. We disagree.

CLAIMS 11–15: COMPUTER READABLE STORAGE MEDIUM

Independent Claim 11 recites, *inter alia*, “[a] computer readable [storage] medium comprising computer executable instructions.” The Examiner interprets this limitation as including “a computer data signal embedded in a digital data stream (carrier wave).” Final Act. 2–3. The Examiner finds Appellants’ definition of “a computer readable storage medium” encompasses “*a signal*.” Ans. 13–14 (citing Spec., ¶ 27).

Appellants merely argue that Claim 11 recites a “computer readable storage medium that includes a memory device that has computer readable program code embodied therewith.”

² Our Decision to REVERSE the rejections of Claims 6–15 under 35 U.S.C. §§ 102 and 103 is not a subject of the present re-hearing.

Appellants fail to draw to our attention any intrinsic evidence, or relevant case law, that would exclude from the claimed “computer readable storage medium” a transient, carrier-wave signal.

Appellants’ Specification merely discloses a “computer readable storage medium may be, for example, *but not limited to*,” certain media, and “specific examples (*a nonexhaustive list*) of the computer readable storage medium would include” certain other media. Spec., ¶ 33 (emphases added). Additionally, the Specification mentions program code “may also be stored in a computer readable medium,” but the Specification does not limit the claimed computer readable storage medium to non-transitory embodiments. *See* Spec., ¶ 27.

Accordingly, the claimed “computer readable storage medium” is not limited to a non-transitory embodiment. Similarly, the Board in *Mewherter* did “not find any limitation on the form of the ‘machine-readable storage medium’ in Appellants’ Specification.” *Ex parte Mewherter*, 107 USPQ2d 1857, 1859 (PTAB 2013) (precedential). Absent such express limitation on the claimed “computer readable storage medium,” the relevant body of extrinsic evidence compels a finding that “the ordinary and customary meaning of ‘computer readable storage medium’ to a person of ordinary skill in the art [is] broad enough to encompass both non-transitory and transitory media.” *Id.* at 1860.

For the reasons discussed *supra*, we are not persuaded the Examiner erred in rejecting Claims 11–15 as non-statutory. Moreover, we are not persuaded that we may have overlooked or misapprehended Appellants’ arguments in this regard.

CLAIMS 6–15: ABSTRACT IDEAS

Incorporation by reference.

Appellants contend that in “the Reply Brief and the Appeal Brief, Appellants demonstrated that Applicants’ claims specify with particularity exactly how the abstract concept of modeling and validating a user process is achieved without foreclosing all possible methodologies for achieving the abstract concept of modeling and validating a user process.” Req. 4.

Appellants argue that their prior briefs, “in line with the jurisprudence of [Federal Circuit case law], . . . concluded that Appellants’ claims specified with particularity exactly how the abstract concept of modeling and validating a user process is achieved without foreclosing all possible methodologies for achieving the abstract concept of modeling and validating a user process.” *Id.*

Appellants do not set forth their supporting arguments, but merely invite our perusal of prior submissions. An invitation we decline. “A brief must make all arguments accessible to the judges, rather than ask them to play archaeologist with the record.” *Corning Inc. v. Danjou’s DSM IP Assets B.V.*, Case No. IPR2013-00043, Paper No. 95 at 12, n.3 (PTAB May 1, 2014) (citing *DeSilva v. DiLeonardi*, 181 F.3d 865, 866–67 (7th Cir. 1999)). The MPEP provides:

The mere filing of a document entitled as [an appeal] brief will not necessarily be considered to be in compliance with 37 CFR 41.37(c). The rule requires that the brief must set forth arguments and the basis therefor, with citations of the statutes, regulations, authorities and parts of the record relied upon. It is essential that the Board be provided with a brief fully stating the position of the appellant with respect to each ground of rejection presented for review in the appeal so that no search of

the Record is required in order to determine that position.
Thus, the brief should not incorporate or reference previous responses.

MPEP § 1205.02. “Accordingly, we will not consider arguments that are not made in the [Request], but are instead incorporated by reference.” *Cisco Sys., Inc. v. C-Cation Techs., LLC*, IPR2014-00454, slip op. 10 (PTAB, Aug. 29, 2014) (informative).

Federal Circuit Jurisprudence.

Appellants contend that our Decision elected not to address the jurisprudence including: *DDR Holdings, LLC v. Hotels.com, L.P.*, 773 F.3d 1245, 1258 (Fed. Cir. 2014); *Internet Patents Corp. v. Active Network, Inc.*, 790 F.3d 1343 (Fed. Cir. 2015); and *Intellectual Ventures I LLC v. Capital One Bank (USA)*, 792 F.3d 1363 (Fed. Cir. 2015). Req. 4.

As noted by Appellants (*see id.*), we were not persuaded by Appellants’ arguments because we found “nothing in the claim recitation that, facially, explains how the validating step is performed.” Decision 7. The Request cites Federal Circuit case law, but without any analysis to explain how the adjudicated claims are similar to the claims at issue. It is not the case that the Board has ignored precedent. Rather, Appellants have failed to show which precedent is relevant and how that precedent may apply.³ *See* Req. 4–5. The Request fails to direct our attention to where the required specificity may be found in either the claims or the Specification.

³ The issue is not that the Federal Circuit has held various claims to recite eligible subject matter under 35 U.S.C. § 101. As Appellants are undoubtedly aware, a far larger body of Federal Circuit jurisprudence has found other claims fail to recite eligible subject matter. The burden is on Appellants, not the Board, to show how their claims distinguish the body of

DECISION

Accordingly, we have granted Appellants' Request to the extent that we have reconsidered the original Decision but have DENIED it with respect to making any changes to the Decision.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

REHEARING DENIED

Federal Circuit case law. *See In re Jung*, 637 F.3d 1356, 1365 (Fed. Cir. 2011).